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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,237	07/06/2001	Florian Stengele		3471

7590 11/29/2004

Felix J. D'Ambrosio  
JONES, TULLAR & COOPER, P.C.  
P.O. Box 2266 Eads Station  
Arlington, VA 22202

EXAMINER

NGUYEN, LEE

ART UNIT PAPER NUMBER

2682

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

### Application No.

09/899,237

### Applicant(s)

STENGELE ET AL.

### Examiner

LEE NGUYEN

### Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/01, 06/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The IDS filed 07/06/01, 06/06/03 have been considered and recorded in the file.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 12-14, the claims are method claims, which depend on apparatus claim 1. Therefore, claims 12-14 are indefinite. In the following art rejection, claims 12-14 are treated as apparatus claims.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-6 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Tapperson (WO 96/12993).

Regarding claim 1, Patterson teaches a field transmitter 76-82 (fig. 2A) for process automation having a control device 110 for data input and display, wherein the control device 110 is in the form of a separately portable unit (fig. 2A), and control device 110 and field transmitter 76-82 are linked by radio (fig. 2A), the radio link being limited to the local area surrounding the field transmitter 76-82 (page 12, 1-3).

Regarding claim 4, Patterson as modified also teaches that an antenna connection 114 is provided on the housing of the field transmitter 76-82 (fig. 2 of Patterson).

Regarding claim 5, Patterson also teaches that the field transmitter 76-82 is used for recording a process variable (page 9, 19-23).

Regarding claim 6, Patterson also teaches that the field transmitter 76-82 is connected to a central control unit by means of a field bus (page 9, 7-30).

Regarding claim 14, Patterson also teaches that the control device is used to make a status query for the purpose of predictive maintenance of the field transmitter (page 11, 4-9, and page 12, 29 through page 13, 3)..

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes

that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson in view of Fillebrown et al. (US 2004/0204041).

Regarding claim 2, Patterson also teaches that the radio link can be different types of wireless link, see col. 12, 1-3. Patterson fails to teach that the radio link is effected on the basis of the Bluetooth standard. In the short-range communication, Fillebrown teaches that the wireless link can be Home RF, IEEE 802.11, Bluetooth. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the Bluetooth protocol of Fillebrown into the system of Patterson in order to use free communication channels without the cost of license.

Regarding claim 3, Patterson as modified also teaches that the field transmitter has a microprocessor P connected to a Bluetooth chipset SE, and wherein the control device B likewise has a microprocessor P1 which is connected to a corresponding Bluetooth chipset SE1 (each device includes microprocessor 205 and inherently connects to Bluetooth chip, see [0063] of Fillebrown.

10. Claims 7, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson in view of Belanger et al. (US 5,875,186).

Regarding claim 7, Patterson fails to teach that the data transmission rate between field transmitter and control device is approximately 1 Mbit/sec. The Bluetooth communication that uses IMS frequency bands with data transmission rate around 1 Mbit/sec is conventionally well known, as taught by Belanger in col. 34, 18-23). Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the 1 Mbit/sec as taught by Belanger to the system of Patterson in order to comply with the FCC regulation.

Regarding claim 10, Patterson as modified teaches that the control device is a portable handheld appliance, see Patterson in page 10, 24.

11. Claims 8-9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson in view of Belanger et al. (US 5,875,186) as applied to claim 7 above and further in view of Fillebrown.

Regarding claims 8-9, Patterson as modified fails to teach that the control device B is a portable computer or a palmtop. Fillerbrown teaches that a control device can be a portable computer or a palmtop. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to provide the laptop or palmtop computer to the system of Patterson in order to achieve more functions in the control device.

Regarding claim 11, Patterson as modified also teaches that the control device is a portable radio telephone, see Fillebrown in [0040].



12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson in view of Hayes et al. (US 5,974,312).

Regarding claim 12, Patterson fails to teach that the control device is used to transmit software changes to the field transmitter. Hayes teaches that software can be changed in short range communication, see col. 2, 56-63 and col. 4, 19-23. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Hayes to the system of Patterson in order to modify the operation of the devices without the cost of replacing hardware.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson in view of Shimizu et al. (US 5,103,409).

Regarding claim 13, Patterson fails to teach that the control device is used to initiate a recurrent test on the field transmitter. Shimizu teaches that a control device is used initiate a recurrent test on the field transmitter (col. 2,

8-25). Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Shimizu to the system of Patterson in order to store the result of the self-diagnosis without a backup power source, and for managing the results of the self-diagnosis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 11/22/04  
LEE NGUYEN  
Primary Examiner  
Art Unit 2682